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In re application of Jens J. Hyldig-Nielsen et al. :
Serial No. : 09/593,914 : DECISION ON PETITION
Filed : June 14, 2000 :
Attorney Docket No.: BP9901US :

This is in response to applicants' petition, filed August 25, 2003 under 37 CFR 1.144, to withdraw the restriction requirement set forth by the examiner.

BACKGROUND

Review of the file history shows that the application was filed June 14, 2000 under 35 U.S.C. 111(a). The application as filed contained 85 claims. On January 15, 2002 the examiner mailed a first Office action on the merits, which included a restriction requirement requiring applicants to elect a single nucleotide sequence for examination. Applicants had elected (telephonically) SEQ ID No: 1. In response, the examiner withdrew claim 34 from consideration and limited examination of the remaining claims to the elected sequence. On February 19, 2002 applicants filed a response in which the restriction requirement was traversed on essentially the same grounds argued in the petition. On July 17, 2002 the examiner mailed an Office action in which the restriction requirement was made final. A final rejection was mailed February 25, 2003, and Applicants filed an appeal brief on February 18, 2004.

DISCUSSION

Applicants argue that it is improper to restrict a single claim into multiple inventions, citing *In re Weber*. This argument is not persuasive. In the *Weber* case, the Court ruled that it was improper for the examiner to reject claims under 35 U.S.C. 121. The examiner has not set forth any rejection based on 35 U.S.C. 121 in this application. Moreover, applicants have not provided any support for their position that an examiner may not find more than one distinct invention within a claim. MPEP 802.01 states, in part:

> The law has long been established that dependent inventions (frequently termed related inventions)...may be properly divided if they are, in fact, "distinct" inventions, even though dependent....The term "distinct" means that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and

unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art).

There is no requirement that the distinct inventions be claimed in separate claims for restriction practice to be applicable. Indeed, MPEP 803.04 provides examples wherein single claims claiming multiple nucleic acid sequences are subject to restriction.

Applicants argue that it would not be a burden to search all of the claimed sequences because they are all classified in the same class and subclass. This argument is not persuasive. Nucleic acid sequences are searched by comparing a sequence to those found in various public and proprietary databases. Unless there is a disclosed common structure shared by two or more sequences, it is impossible to simultaneously search for more than one sequence.

DECISION

Applicants' petition is **DENIED**.

Since no fee is required for this petition, $130.00 will be refunded to deposit account 02-3240, as directed.

The application will be forwarded to the examiner for consideration of the appeal brief filed February 18, 2004.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

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